

# IP Estate Planning

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# IP Estate Planning

## ▣ Intellectual Property

- Generally treated as intangible personal property
- **Copyright**
  - Work (literary, dramatic, musical, and artistic)
- **Trademark**
  - Brand (names, logos, and trade dress)
- **Right of Publicity**
  - Persona (name and likeness)
- **Patent**
  - Invention (technologies and designs)

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## Copyright

- ▣ Protects Expression (not underlying idea)
- ▣ Copyright exists when an original work of authorship is fixed in a tangible medium of expression
- ▣ Registration not required to acquire copyright
- ▣ Registration is a requirement to file lawsuit against infringer

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## Copyright

### ▣ Bundle of Rights

- Reproduction
- Derivative Work (adaptation)
- Distribution
- Public Performance
- Public Display

### ▣ Fair Use

- Transformative (purpose and character of the use)

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## Copyright

- ▣ 17 U.S.C. § 102 – Works of authorship
  - Literary works;
  - Musical works, including any accompanying words;
  - Dramatic works, including any accompanying music;
  - Pantomimes and choreographic works;
  - Pictorial, graphic, and sculptural works;
  - Motion pictures and other audiovisual works;
  - Sound recordings; and
  - Architectural works.



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## Copyright

- ▣ Author as owner of Copyright
  - 17 U.S.C. § 201(a) – “Copyright in a work protected under this title vests initially in the author or authors of the work.”



*Monkey Selfie*

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## Copyright

- ▣ What is not protectable?
  - Public Domain
  - Ideas or Concepts
  - Recipes (idea/ expression)
  - Listings (*e.g.*, telephone book)
  - U.S. Government works
  - Works not fixed in a tangible medium of expression
  - Titles, Phrases, Typefaces, Logos

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## Copyright

### ▣ Federal Law

- Works before 1978 are governed by Copyright Act of 1909, works after are governed by Copyright Act of 1976

### ▣ Term *(pre-1978 works may have different term)*

- ▣ Life of author plus 70 years
- ▣ For works made for hire:
  - 95 years from the first publication or 120 years from creation, whichever expires first

### ▣ Ownership

- *In re Marriage of Worth*, 241 Cal. Rptr. 135 (1987)
- *Rodrigue v. Rodrigue*, 218 F.3d 432 (5th. Cir. 2000)



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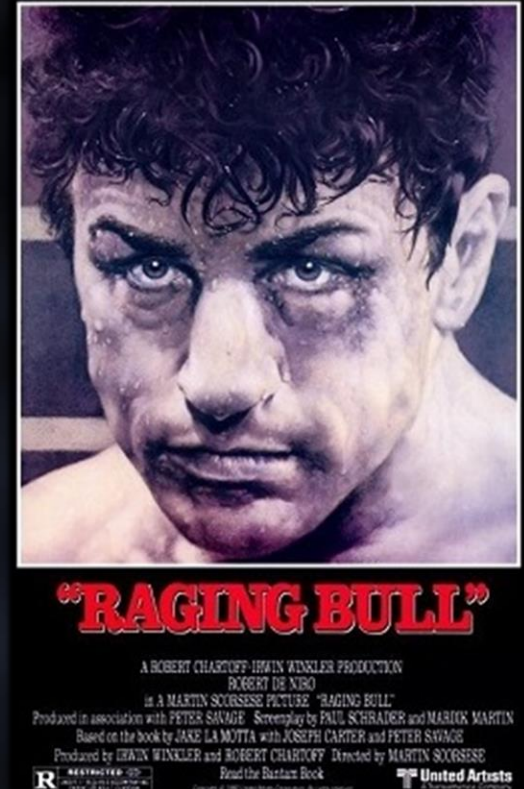
## Copyright

### ▣ Laches

- Not a bar against lawsuit for copyright infringement within the three-year statute of limitations
- Copyright infringement follows “separate-accrual rule”

### ▣ RAGING BULL

- Author’s heir, Paula Petrella, alleged infringement in **1998**; but did not file lawsuit until **2009**
  - *Petrella v. MGM*, 134 S.Ct. 1962 (2014)



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## Copyright

- ▣ Work Made for Hire (Copyright Act of 1976)
  - The employer, and not the employee, is considered to be the author for a work made within the scope of his or her employment
    - “Employee” follows law of agency
  - If independent contractor creates a “specially ordered or commissioned” work in one of nine limited categories, there must be a written agreement specifying that it is a work made for hire

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## Copyright

- ▣ Work Made for Hire by Independent Contractor:
  - ▣ contribution to a collective work,
  - ▣ part of a motion picture or other audiovisual work,
  - ▣ translation,
  - ▣ supplementary work,
  - ▣ compilation,
  - ▣ instructional text,
  - ▣ a test,
  - ▣ answer material for a test,
  - ▣ atlas

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## Copyright

- ▣ Right of Termination
- ▣ Copyright in “work made for hire” is not terminable
- ▣ *Marvel v. Kirby, et al.*
  - Jack Kirby’s heirs sent termination notices in 2009 for works created by Kirby between 1958 and 1963 for Marvel Comics (including Avengers #1)
    - ▣ 2nd Circuit held works were made for hire under old pre-1976 “instance and expense” test
      - *Marvel Characters Inc. v. Kirby*, 726 F.3d 119 (2d Cir. 2013)





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## Copyright

- ▣ Right of Termination
  - Copyright transferred to a Trust may be terminated
  - Copyright transferred by a Will is not terminable
- ▣ Estate Planning Options:
  - Specifically exclude copyrights from general assignments of personal property to a Trust
  - Specifically include copyrights in a stand-alone or residuary clause of a Will



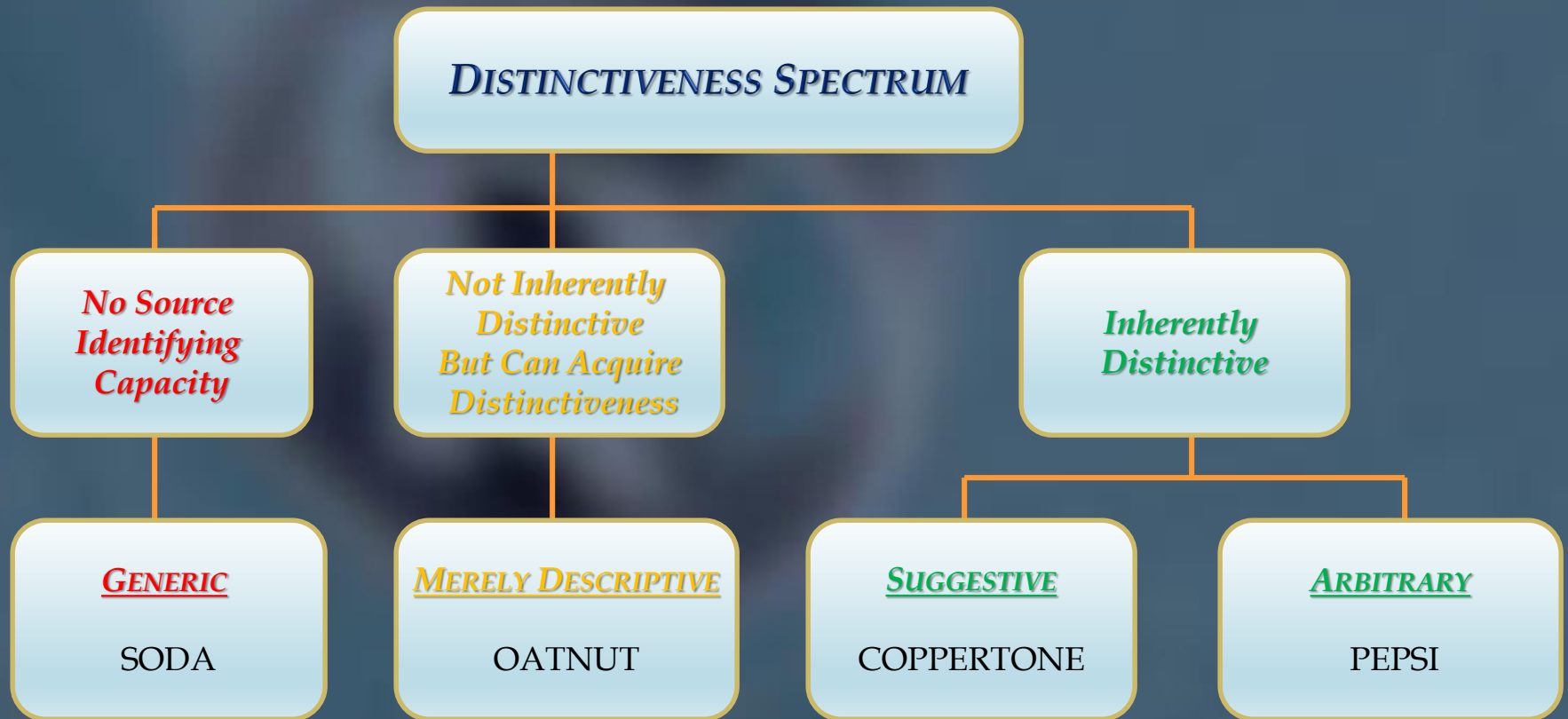
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## Trademark

- ▣ Word, symbol, etc. used with goods or services to indicate their source
  - ▣ Must be distinctive to act as a source indicator
- ▣ Common Law <sup>TM</sup>
  - ▣ Protection based on use in commerce
- ▣ State Registration
  - ▣ Individual U.S. states
- ▣ Federal Registration ®
  - ▣ U.S. Patent and Trademark Office (USPTO)

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## Trademark



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## Trademark

### ▣ *TYPES OF TRADEMARKS:*

- Word Mark

**NIKE**

- Design Mark



- Composite Mark containing both word and design



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## Trademark

- ▣ Shape: Bottle shape for soft drinks
- ▣ Color: Red-soled shoes
- ▣ Sound: Three chimes for television broadcasting
- ▣ Scent: Cherry scent for synthetic lubricant
- ▣ Motion: Animated production logo for movies



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## Trademark

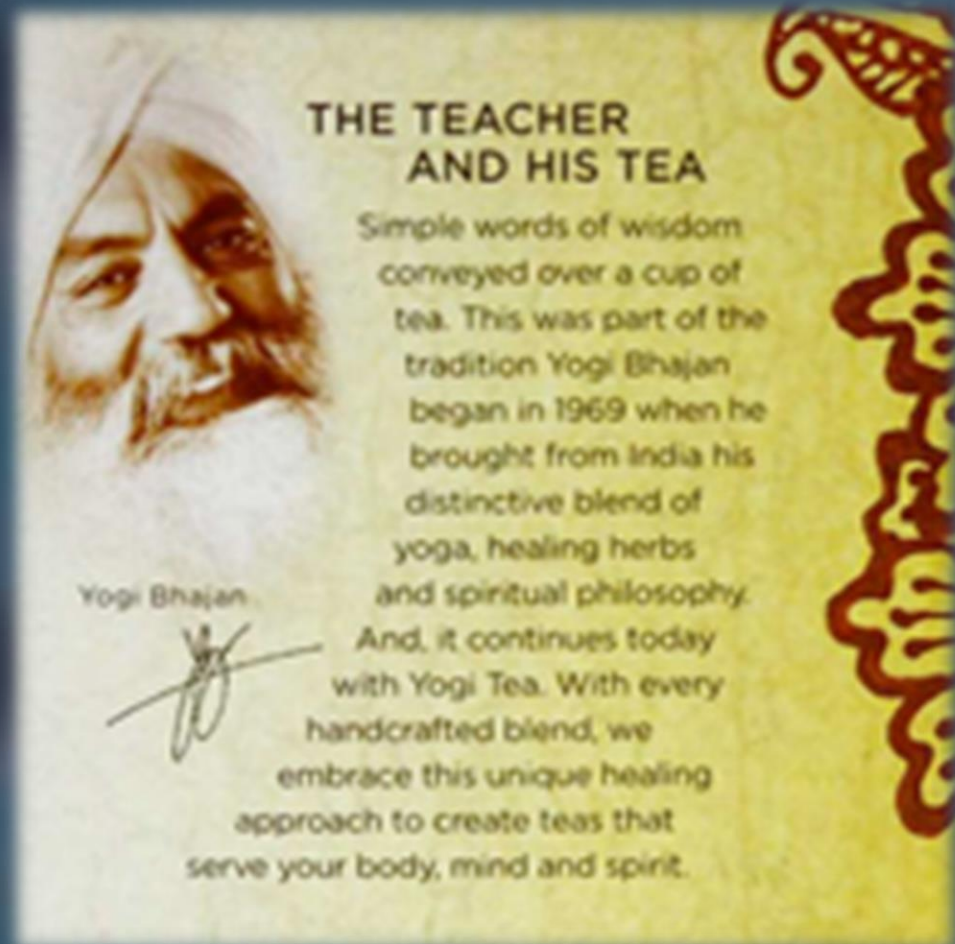
- ▣ Federal and state law
- ▣ Term
  - Potentially perpetual, if there is continued use
  - Registered trademark requires periodic renewal
- ▣ Ownership
  - Transfer must include goodwill
    - ▣ Naked trademark assignment in gross not valid
  - Usually owned by business entity
    - ▣ Sometimes personally owned and licensed to business



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## Trademark

- ▣ YOGI TEA
  - Yogi Bhanjan
  - Bibiji (wife)
  - Living Trust
  - Golden Temple of Oregon



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## Trademark

### ▣ YOGI TEA

- Bibiji (widow)
  - ▣ 1/2 Interest
- Administrative Trust
  - ▣ 1/2 Interest
- Golden Temple of Oregon
  - ▣ License from Trust



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## Right of Publicity

- ▣ Use of One's Name, Image, Likeness, Voice, *etc.*
  - Compare with False Association under Lanham Act § 43(a) and with USPTO Registrations for the name of a celebrity used with specific goods or services
    - ▣ Elizabeth Taylor
      - U.S. Reg. No. 4756095
    - ▣ Taylor Swift
      - U.S. Reg. No. 3812830

The image shows a USPTO trademark registration for the name "ELIZABETH TAYLOR". The text is in a serif font, with "ELIZABETH" in a smaller size above "TAYLOR". The background is a light beige color with a subtle border.The image shows a USPTO trademark registration for the name "Taylor Swift". The text is in a cursive script font. The background is a light beige color with a subtle border.



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## Right of Publicity

- ▣ State law
  - ▣ Common Law
  - ▣ Statute
- ▣ Term varies by state
  - ▣ Post-mortem rights (if any) governed by state or country of domicile at death
- ▣ Ownership
  - ▣ *Crosby v. HLC Properties*, 223 Cal.App.4th 597, 609 n.10 (right of publicity “appears” to be separate property)

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## Right of Publicity

- ▣ Marilyn Monroe
  - Died in California
  - Estate claimed she had been domiciled in NY (avoid CA taxes)
  - But NY has no post-mortem right of publicity
  - Estopped from claiming CA domicile
    - *Milton H. Greene Archives, Inc. v. CMG Worldwide Inc.*, 692 F.3d 983 (9th Cir. 2012)
  - Can still license copyrighted images and assert trademark rights

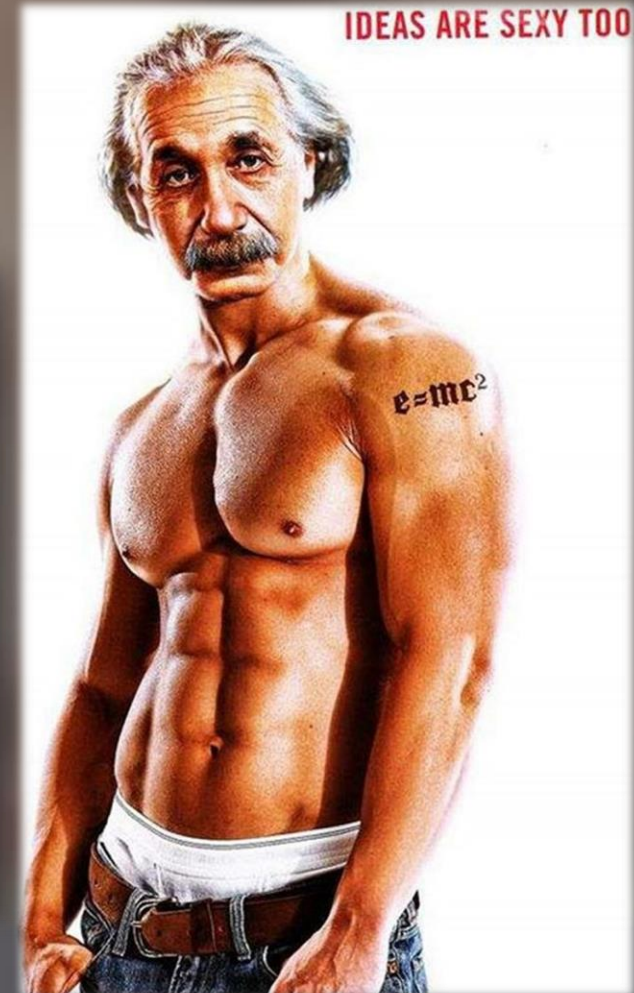
A black and white image of Marilyn Monroe's handwritten signature in cursive script, written on a white background.



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## Right of Publicity

- ▣ Albert Einstein
  - Domiciled in New Jersey
  - Hebrew University of Jerusalem
    - ▣ “literary property and rights” under Einstein’s will
  - GM ad in 2010
  - 50 year term (absent NJ statute)
    - ▣ *Hebrew Univ. of Jerusalem v. GM*, 903 F.Supp.2d 932 (C.D. Cal. 2012)



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## Right of Publicity

### ▣ Jimi Hendrix

- Domiciled in NY at death
- Washington state statute not limited by domicile
- Extraterritorial effect?
  - ▣ *Experience Hendrix v. Hendrixlicensing.com*, 762 F.3d 829 (9th Cir. 2014)



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## Right of Privacy – Appropriation

- Personal right, not a property right
  - *Peterson v. Idaho First Nat'l Bank*, 367 P.2d 284 (Idaho 1961)
    - invasion of privacy includes the appropriation, for defendant's own advantage, of plaintiffs' name or likeness
      - (citing Prosser law review article)
- Source: **Rothman's Roadmap To The Right of Publicity** at <https://www.rightofpublicityroadmap.com/law/idaho>

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## Patent

- ▣ Utility Patent
  - Protects how an invention works
  - Term: 20 years from filing date of application\*
  
- ▣ Design Patent
  - Protects how an invention looks (ornamental features)
  - Term: 15 years from issue date of design patent\*



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## Patent

- ▣ Federal Law
- ▣ Term
  - Different for Utility and Design patents
- ▣ Ownership
  - “patents...have the attributes of personal property”
    - ▣ 35 U.S.C. § 261
  - Ownership generally controlled by state law
    - ▣ *Enovosys v. Nextel*, 614 F.3d 1333 (Fed. Cir. 2010)
    - ▣ *Akazawa v. Link New Tech.*, 520 F.3d 1354 (Fed. Cir. 2008)



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## Patent

- ▣ Death of Inventor — USPTO Issues
  - “Legal representatives of deceased inventors ... may make application for patent” on behalf of the deceased inventor
    - ▣ 35 U.S.C. § 117
  - If an inventor dies after the filing of the application but before issuance, the patent may be issued to the legal representative upon “proper intervention”
    - ▣ Submission of a substitute statement by the legal representative to the USPTO

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	Copyright	Trademark	Publicity	Patent
<i>Term Length</i>	Life + 70 yrs  (...for hire) shorter of 95 yrs after publication, or 120 yrs after creation	Indefinite, if there is continued use in commerce	Post-Mortem rights, if any, depend on state or country of domicile	(utility) 20 yrs from filing date*  (design) 15 yrs from issue date*
<i>Maintenance</i>	none (unless pre-1978)	Decl of Use by 6 <sup>th</sup> yr  Renewal by 10 <sup>th</sup> yr	Post-Mortem, may require registration with state's Secretary of State	(utility) fees at 3½, 7½, and 11½ yrs  (design) no

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